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OFFICE OF PETITIONS

In re Patent No. 6,505,391
Philippe Berna
Issue Date: January 14, 2003
Application No. 08/580,493
Filed: December 29, 1995
Title: PROCESS FOR MAKING A
VERSATILE CLAMPING DEVICE
DESIGNED TO HOLD OBJECTS
WITHOUT DAMAGING THEM, SUCH A
DEVICE AND ITS USE

DECISION ON
REQUEST FOR RECONSIDERATION

This is in response to the RESPONSE TO THE DECISION ON PETITION FILED ON JULY 11, 2003 ACCOMPANIED BY AN AFFIDAVIT AND A REQUEST THAT A LATER INITIAL DATE COULD BE SET FOR THE PERIOD FOR RESPONSE BECAUSE OF FORCE MAJEURE filed March 10, 2006. The application file was recently forwarded to the undersigned for consideration of the petition.

By decision mailed December 20, 2005, the "PETITION FOR SUSPENSION OF THE RULES WHICH WOULD CONFER RETROACTIVITY (PRIOR TO JUNE 8, 1995) AND DISCRIMINATIVE FORCE TO URAA BY OVER-INTERPRETATION," filed July 14, 2003 was dismissed. The decision set a two-month period for response, pursuant to 37 CFR 1.181(f). Receipt of the status inquiry filed June 16, 2004, is acknowledged.

The instant request for reconsideration was filed beyond the two-month period with explanation for the delay. It has been determined that the petition will not be dismissed as untimely without consideration on the merits.

With respect to the merits of the petition, for the reasons stated herein, the petition is DISMISSED.

The conclusion that the patent is subject to the twenty year patent term provisions of 35 U.S.C. 154(a)(2) is affirmed. In addition, subject to any disclaimer, the twenty year term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 19 days for examination delay.

BACKGROUND

Patentee requests reconsideration of the decision mailed December 20, 2005, denying patentee's request that the twenty year patent term provisions of 35 U.S.C. 154(a)(2) not be applied to U.S. Patent No. 6,505,391 and that instead the patent be given a term of 17 years from date of issuance, and as such, not expire until January 10, 2020.

On request for reconsideration, patentee denies that the subject patent No. 6,505,391 issued from a continued prosecution application filed August 16, 2001¹. Patentee declares that he ever and only filed continuing applications under former rule 62 in the spirit of making requests for continued examination of my patent application. Specifically, patentee argues that the application filed under former rule 62 on August 16, 2001 should have been treated as an RCE because it was filed after May 29, 2000.

RELEVANT STATUTES AND REGULATIONS

35 U.S.C. 154(a)(2)

TERM --Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, or 365(c) of this title, from the date on which the earliest such application was filed.

35 U.S.C. 154(c)(1)

DETERMINATION. --The term of a patent that is in force on or that results from an application filed before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act² shall be the greater of the 20-year term as provided in subsection (a), or 17 years from grant, subject to any terminal disclaimers.

DISCUSSION

Petitioner's arguments have been considered, but not found persuasive. The prior decision has been carefully reconsidered in light of petitioner's arguments and a further review of the application history and of the relevant statute and rules. This reconsideration confirms the conclusion that U.S. Patent No.

¹ A petition to accord a filing date of August 16, 2001 to the CPA, rather than August 23, 2001, was granted.

² The implementation date of the URAA is June 8, 1995. See Changes to Implement 20-Year Patent Term and Provisional Applications, Final Rule, DATE...

6,505,931 issued from a continuing prosecution application filed August 16, 2001 is proper. Thus, the conclusion that U.S. Patent No. 6,505,391 is subject to the twenty year patent term provisions of 35 U.S.C. 154(a)(2) and thus, properly has a term beginning on January 14, 2003, the date of issuance of the patent, and ending 20 years after the earliest effective filing date claimed by applicant (section 120, 121, or 365(c) of this title) is affirmed.

By law, the term of a patent is determined by the filing date of the application that it issued from. Generally, pursuant to 35 U.S.C. 154(c), a patent that issued on an application that was filed before June 8, 1995 has a term that is the greater of the 20 year term or 17 years from grant. Generally, pursuant to 35 U.S.C. 154(a)(2), a patent that issued on an application that was filed after June 8, 1995 has a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States (or the date on which the earliest application to which the application claims priority was filed).

The filing of a request for continued examination (RCE) is not a new application and has no effect on the determination of patent term. Whereas, the filing of a continued prosecution application (CPA)³ is legally the filing of a new application. When a continued prosecution application is filed in an application, the filing date of the CPA becomes the date of filing of the prior application for purposes of determining patent term. Moreover, a CPA filed on or after May 29, 2000, renders the application entitled to the benefits of the patent term adjustment provisions of 35 U.S.C. 154(b) and 37 CFR 1.702 through 1.705, regardless of the filing date of any prior application.

In this instant, applicants filed an application under former rule 62 on May 15, 2000 and again on August 16, 2001. Both of these applications were properly treated as CPAs. Both MPEP, Seventh Edition, First Revision, February 2000 in effect on May 15, 2000 and MPEP, Original Eighth Edition, August 2001 in effect on August 16, 2001, at MPEP 201.06(b) provided that:

A continuation or divisional application filed under former 37 CFR 1.62 on or after December 1, 1997, will be treated as an application filed under 37 CFR 1.53(d) unless the application is a utility or plant application filed on or after May 29, 2000, in which case it will be treated as a request for continued examination (RCE) under 37 CFR 1.11.

Petitioner cites these MPEP sections in support of their argument that the application under former rule 62 filed August 16, 2001 should have been treated as an RCE. However, petitioner has not properly applied these provisions to the instant application. To support a conclusion that the paper filed August 16, 2001 should

³ Effective July 14, 2003, CPA practice under 37 CFR 1.53(d) does not apply to utility and plant applications. CPAs can only be filed in design applications. See *Elimination of Continued Prosecution Application Practice as to Utility and Plant Patent Applications*, final rule, 68 Fed. Reg. 32376 (May 30, 2003), 1271 Off. Gaz. Pat. Office 143 (June 24, 2003).

be treated as a RCE, petitioner emphasizes the portion of the sections stating "unless the application is a utility or plant application filed on or after May 29, 2000, in which case it will be treated as a request for continued examination (RCE) under 37 CFR 1.11." Petitioner argues that the application filed under former rule 62 on August 16, 2001 should have been treated as an RCE, because it was filed after May 29, 2000. However, this application of MPEP 201.06(b) is incorrect.

The condition referred to in MPEP 201.06(b) and necessary for the paper filed August 16, 2001 to be treated as a RCE did not occur. It is not sufficient just that the application under former rule 62 be filed on or after May 29, 2000. Rather, the application in which the application under former rule 62 is filed must be a utility or plant application filed on or after May 29, 2000 in order for the application under former rule 62 to be treated as a RCE. At the time of the filing of the continuation under former rule 62 on August 16, 2001, this application was not a utility or plant application filed on or after May 29, 2000. This was an application in which an application under rule 62 was filed on May 15, 2000, after December 1, 1997 but prior to May 29, 2000. Accordingly, both the application under rule 62 filed May 15, 2000 and the application under rule 62 filed August 16, 2001 were properly treated as a CPA.

In other words, these sections provided that a second CPA filed in an application after May 29, 2000 would be treated as a RCE. Because a CPA is legally a new application, the first CPA filed on or after May 29, 2000, causes the application to be treated as an application filed on or after May 29, 2000. Accordingly, the second CPA filed after May 29, 2000, should be treated as a RCE. In this instance, the application under former rule 62 filed August 16, 2001 was the first CPA filed after May 29, 2000 and was properly treated as such.

Petitioner argues that revisions 2 (May 2004) and 3-4 (August - October 2005) of the Eighth Edition of the MPEP have even removed the restriction that the application under former rule 62 should be "filed on or after May 29, 2000," for being treated as an RCE in the paragraph 201.06(b).

The revisions to the MPEP do not support a conclusion that the Office has come to a conclusion (as argued by petitioner at page 2 of the instant petition) that any continuation paper filed under former rule 62 should be treated as an RCE. Rather, the revisions reflect that a CPA can no longer be filed in a utility or plant application. Effective July 14, 2003, CPA practice under 37 CFR 1.53(d) does not apply to utility and plant applications. CPAs can only be filed in design applications. See Elimination of Continued Prosecution Application Practice as to Utility and Plant Patent Applications, final rule, 68 Fed. Reg. 32376 (May 30, 2003), 1271 Off. Gaz. Pat. Office 143 (June 24, 2003). Accordingly, the Office no longer treats a continuation paper filed under former rule 62 as a CPA. The 2004 and 2005 revisions of the MPEP do not apply to the paper filed August 2001.

Given the rules in effect on August 16, 2001 by filing an application under former rule 62 on that date rather than filing

a RCE, applicant effectively filed a CPA and became subject to the twenty year provisions.

Any request for reconsideration must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are not permitted. See 1.181(f).

Further correspondence with respect to this decision should be addressed as follows:

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Telephone inquiries with regard to this communication should be directed to the undersigned at (571) 272-3219.



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